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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/650,289 | 08/28/2003 | Bradley D. Schweigert | KMC-598 | 6682 |

39915 7590 04/27/2006

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LEGAL DEPARTMENT
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EXAMINER

HUNTER, ALVIN A

| | |
|----------|--------------|
| ART UNIT | PAPER NUMBER |
|----------|--------------|

3711

DATE MAILED: 04/27/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|--------------------------------------|--|--|
| Office Action Summary | Application No. 10/650,289 | Applicant(s) SCHWEIGERT ET AL. | |
| | Examiner Alvin A. Hunter | Art Unit 3711 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 January 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5,7 and 15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5,7 and 15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-5, 7, and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nasu (JP 2000-005358) in view of Antonious (USPN 5246231).

Regarding claim 1, Nasu discloses a putter comprising a club head body having a toe region, a heel region, a sole, and a top surface opposite the sole, a hosel connected to the club head body, a shaft received in the hosel wherein the shaft has a longitudinal axis which intersects the center of gravity of the club head body. The club head body also has a toe thickness defined by a distance between the top surface and the sole in the toe region and a heel thickness defined by a distance between the top surface and the sole in the heel region wherein the toe thickness is being greater than the heel thickness. Nasu does not disclose cutouts formed in the heel and toe regions. Antonious discloses a putter having undercuts in order to position the weight of the heel and toe closer to the center of percussion and notes that the size and location of the undercut is key in achieving such (See Abstract and Column 3, lines 23 through 34). One having ordinary skill in the art would have found it obvious to have an undercut, as taught by Antonious, within the putter head of Nasu in order to adjust the overall weight such that the center of gravity is closer to the center of percussion.

Regarding claim 2, Nasu shows the upper portion of the hosel located at substantially midway between the toe and heel region.

Regarding claims 3 and 4, Applicant recites on page 4, paragraph 0018

"Top surface 130 may be of any suitable shape, width, and length. . . . The present invention, however, is not so limited, and contemplates any suitable club head shape."

At the time the invention was made, it would have been an obvious matter of design choice to a person of ordinary skill in the art to have a concave top surface. Applicant has not set forth that having a concave top surface provides any advantage, particular purpose, or solves a stated problem. One having ordinary skill in the art would have concluded that any configured top surface would suffice. It is also submitted that the combination of Nasu in view of Antoniuos meets the above based on the insufficient evidence showing that the top surface configuration provides an advantage, particular purpose, or solved a stated problem.

Regarding claim 5, Nasu does not explicitly disclose the toe-up factor being 1.20 to 1.40, one having ordinary skill in the art would have recognized that Nasu inherently has a toe-up factor being that the drawings show the heel region being less than the toe region and that any factor may be multiplied to the thickness of the heel region such that the value equals that of the toe region. . Furthermore, applicant does not disclose why the values of the toe-up factor are critical in order to attain the invention; therefore, one having ordinary skill in the art would have found it obvious to have the toe-up factor of any value so long as the invention is attained (See *Gardner v. TEC Systems, Inc., et al.* 220 USPQ 777).

Regarding claim 7, Applicant notes on page 5, paragraph 0022

Art Unit: 3711

"In the illustrated embodiment shown in Figs. 2 and 4, cut-outs 202 and 204 have similar shapes, but have different depths. It will be appreciated, however, that the present invention is not so limited. For example, cut-outs 202 and 204 may have the same depth but different shapes, or may comprise multiple cut-outs (e.g., perforations and the like) distributed to produced the desired weight balancing."

Antonious discloses the undercut having a depth and notes that the size of the undercut being such that it adjusted the overall weight of the heel and toe closer to the center of percussion. At the time the invention was made, it would have been an obvious matter of design choice to a person of ordinary skill in the art to have a undercuts of different depths. Applicant has not set forth that having different depths provides any advantage, particular purpose, or solves a stated problem. One having ordinary skill in the art would have found it obvious to have undercuts of any depth so long as the weight is adjusted such that the weight is closer to the center of percussion.

Regarding claim 15, Nasu disclose the hosel comprising a bore formed in the top surface of the club head body.

Response to Arguments

Applicant's arguments with respect to claims 1-5, 7, and 15 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alvin A. Hunter whose telephone number is (571) 272-4411. The examiner can normally be reached on Monday through Friday from 7:30AM to 4:00PM Eastern Time.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gene Kim, can be reached on 571-272-4463. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Alvin A. Hunter, Jr.



EUGENE KIM
SUPERVISORY PATENT EXAMINER